

## **REMARKS**

This response is submitted in reply to the outstanding office action of March 30<sup>th</sup>, 2006. Reconsideration of the application in view of this response is respectfully requested. Applicant avers that the amendment is responsive to all issues raised in the action and that no new matter is added to application as part of this amendment.

### **The Office Action**

In the action, the Examiner objected to title of the invention and proposed a suggested title. Applicant has amended the application in accordance with the Examiner's suggestion and requests that this objection is withdrawn in view of the above amendment.

The Examiner rejected claims 1-25 under 35 U.S.C. § 102(b) as being anticipated by MacMillan et al. Applicant respectfully request that the Examiner reconsider the rejection in view of the below remarks.

To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. With respect to those elements that are present, the single source must disclose all of the claimed elements "arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

Both independent claims 1 and 25 include the element "(ii) contacting the initial fuel composition with a caustic material to provide the fuel composition." Item (ii) of claim 1 further includes the element "without subsequent addition of a corrosion inhibitor." The reference does not disclose that the caustic material is added to the fuel after the corrosion inhibitor is added to the fuel. See pages 4 and 5 of the reference.

Also, the claimed corrosion inhibitor and the compound of formula (I) of the reference are not the same. The claimed corrosion inhibitor of the application added to the

fuel, in one embodiment, at least one of  $R_2$  or  $R_3$  is represented by a hydroxyl group (-OH).

In a second embodiment of the claimed corrosion inhibitor which is added to the fuel,  $R_2$  and  $R_3$  together may be represented by "-O-."

The reference discloses that  $R_2$  and  $R_3$  of the reference compound are both hydroxyl terminated alkoxy groups, such as  $(-OCH_2CH_2)_n-OH$ . See page 3 of the reference. The reference does not disclose that either one of  $R_2$  or  $R_3$  may be a hydroxyl group. Also, the reference does not teach an embodiment of the reference compound formula (I) in which  $R_2$  and  $R_3$  together are represented by "-O-" and that such a compound is added to a fuel.

Applicant does agree with the Examiner that the reference does include a compound in which  $R_2$  and  $R_3$  together are represented by "-O-." However, Applicant respectfully states that the reference explicitly discloses that the compound in the reference in which  $R_2$  and  $R_3$  are represented by "-O-" is used as a reactant to form the reference compound formula (I) which is added to the fuel. The reference compound in which  $R_2$  and  $R_3$  are represented by "-O-" is reacted with an alcohol of  $R_2OH$  and/or  $R_3OH$  to produce the reference compound of formula (I) that is added to the fuel. See page 5 of the reference.

Applicant respectfully traverses the rejection for the reasons that the reference does not disclose each and every element of the independent claims 1 and 25 and that the reference does not disclose the elements of claims 1 and 25 as arranged in the claims.

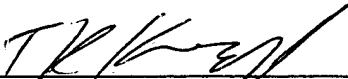
### CONCLUSION

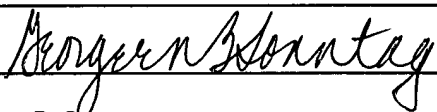
For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-25) are now in condition for allowance.

Respectfully submitted,

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August 25, 2006  
Date

  
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